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Application No.: 10/521826

Case No.: 58046US013

REMARKS

Claims 1 – 30 are pending. Claims 1, 5, 15, and 19 are being amended.

Rejections Under 35 U.S.C. § 112

Claims 1 – 30 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The rejection is respectfully traversed for the following reasons.

Regarding claims 1 – 30, the Examiner has asserted that it is unclear whether the list of specific definitions of terms provided in the specification defines claim terminology. The Federal Circuit has ruled that where an explicit definition is provided by the Applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999). Therefore, Applicants believe it is clear that the specific definitions of terms provided in the specification should control interpretation of the terms in the claims.

Regarding claims 1 and 15, the Examiner has asserted that it is unclear whether the described structure involving a support, a metal layer, and a protective layer necessarily requires that the “extensible metal or metal alloy layer” is sandwiched by the support and protective layer. Amended claims 1 and 15 now specify that the film comprises a flexible support, a visible light-transmissive crosslinked polymeric protective layer, and an extensible visible light-transmissive metal or metal alloy layer sandwiched therebetween.

Regarding claims 2, 16, and 30, the Examiner has asserted that it is unclear how the metal layers can be other than substantially continuous in view of the extensibility definition which precludes discontinuities. Paragraph [0007] of Applicants’ specification states, “Preferably, the metal or metal alloy layers are substantially continuous over substantial areas of the film, i.e., over portions of the film where EMI shielding, heating, or like functionality is desired. In some embodiments, the metal or metal alloy layers can be completely continuous over the entire film; in other embodiments the metal or metal alloy layers can be patterned to define a limited number of apertures, holes, or channels for desired functionality (e.g. to provide one or more frequency selective surfaces or distinct, electrically conductive pathways). Therefore, the metal or metal

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alloy layers can be discontinuous because, for example, they are patterned. This is not inconsistent with Applicants' extensibility definition. Paragraph [0026] states that an "extensible" metal layer is a layer that when incorporated into a light-transmissive film or article can be stretched by at least 3% in an in-plane direction without loss of electrical continuity and without forming visible discontinuities in the surface of the metal layer as detected by the naked eye at a distance of about 0.25 meters. A patterned (i.e., discontinuous) metal or metal alloy layer) can be extensible. A patterned metal or metal alloy layer is extensible if it can be stretched by at least 3% in an in-plane direction without loss of electrical continuity and without forming visible discontinuities in the surface of the patterned metal layer as detected by the naked eye at a distance of about 0.25 meters.

Regarding claims 5 and 19, the Examiner has asserted that it is unclear whether the claimed two layers describe layers in addition to the "extensible metal or metal alloy layer" or whether the claimed two layers may or may not be "extensible metal or metal alloy layer." Amended claims 5 and 19 clarify that the layers are extensible metal or metal alloy layers in addition to the first extensible metal or metal alloy layer.

Regarding claims 10 – 14 and 24 – 28, the Examiner has asserted that it is unclear what is meant by the phrase "an electromagnetic shielding capability that is retained" because it is not clear if the claimed retention requires no diminution in capability or merely some finite amount of capability. Applicants do not agree that the phrase "an electromagnetic shielding capability that is retained" is unclear. One skilled in the art would recognize that the claimed retention requires that the EMI shielding film can still block the transmission of unwanted electromagnetic energy out of or into electronic equipment and other devices that can cause or are sensitive to electromagnetic interference. Furthermore, one skilled in the art would recognize that the claimed retention does not require no diminution in capability. The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999) (The Board's construction of the claim limitation "restore hair growth" as requiring the hair to be returned to its original state was held to be an incorrect interpretation of the limitation. The court held that one of ordinary skill would construe "restore hair growth" to mean that the claimed

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method increases the amount of hair grown on the scalp, but does not necessarily produce a full head of hair.).

In view of the foregoing, Applicants submit that the claims 1 – 20 are indeed clear and definite. Applicants therefore respectfully request that the rejections under 35 U.S.C. § 112, second paragraph, be withdrawn.

Concluding Remarks

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration and allowance of Applicants' claims are respectfully requested.

Respectfully submitted,

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Date

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